

REMARKS

Applicants respectfully request entry of this Amendment and reconsideration of the Office Action mailed September 21, 2007.

I. General Remarks Regarding the Content of this Amendment

Upon entry of this Amendment, claims 1, 2, 4-38, and 40-56 remain pending in this application. Claims 56-60 and 68-76 have been withdrawn from further consideration pursuant to a Restriction Requirement. The independent claims have been amended to further clarify that the base is formed as a single piece element that extends substantially around the second end of the hollow body and forms a support surface for contacting the ground. Support for this change is readily evident from the original disclosure, figures and claims. Accordingly, no new matter is included in this Amendment, and no additional claim fees are due as a result of this Amendment.

II. Applicants' Claims Define Patentable Subject Matter

A. The Cheng '762 Patent is Not Available as Prior Art Against Claims 1, 4-11, 15, 16, 20-28, 33, 34 and 36

Claims 1, 4-11, 15, 16, 20-28, 33, 34 and 36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,938,762 to Cheng (hereinafter "Cheng '762"). Applicants respectfully traverse this rejection and request reconsideration.

Applicants respectfully request reconsideration of the Declaration of the inventors under 37 C.F.R. § 1.131 filed previously. The Office asserts that the declaration was inadequate to withdraw all rejections based on the Cheng '762 reference. The Office further asserts that the "declaration fails to show that the bottom is made from one piece." *See* the Final Office Action at p. 5. Applicants respectfully disagree. Several exhibits filed with the Declaration depict the bottom as being one piece. For instance, Exhibit C shows a one piece bottom. Durable inserts are shown in the figure but, as indicated in the exhibit, they are only included "as needed." *See* Declaration Exhibit C filed March 19, 2007. In addition, Exhibit D depicts the bottom as a single piece. Exhibit E also shows the base as a single unit. Additional durable inserts are shown in Exhibit E. However, these inserts, that may or may not be used in conjunction with the one piece base, do not detract from the base itself being a single piece. Exhibits F and G further illustrate a base formed of a single piece element. While additional inserts or wear guards may

be used with the bag, the base itself is shown as one piece. Accordingly, Applicants respectfully assert that the Declaration filed does indeed show the base as being a single piece, as recited in Independent claims 1, 20, and 38.

Further, the Office asserts that “the evidence presented fails to teach the indentation from the inside surface and the handle as claimed.” *See* the Final Office Action at p.5. Applicants respectfully assert that none of independent claims 1, 20, or 38 recite features of the bag including the indentation on the inside surface or a handle.

Accordingly, Applicants respectfully assert that the evidence presented in the Declaration is sufficient to establish a date of conception and reduction to practice prior to May 28, 2003, the filing date of Cheng ‘762. Cheng ‘762 is therefore not valid as prior art against the present claims, and Applicants respectfully request withdrawal of these rejections.

B. Claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, and 34 Patentably Distinguish from Cheng ‘362

Claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, and 34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,386,362 to Cheng (hereinafter “Cheng ‘362”). Applicants respectfully traverse this rejection and request reconsideration.

Amended independent claims 1 and 20 recite, among other features, “[a] golf bag comprising...a base secured to the second end of the body, the base *formed of a single piece element that extends substantially around the second end of the body.*” (Emphasis added). Cheng ‘362 fails to teach or suggest a base formed of a single piece element. The amendment is made in response to the assertion by the Office that the previously used claim term “‘one piece’ is broad and does not exclude the other part coming together to form one piece item.” *See* the Final Office Action at p. 4-5. While Applicants do not agree with the assertion of the Office, Applicants assert that a base made from a plurality of parts clearly can not be considered *formed of a single piece element*, as recited in claims 1 and 20.

Cheng ‘362 describes a golf bag including a base seat. Col. 2, lines 43-45. The base seat includes a front section, a rear section and a pivot section connected between the front and rear sections. Col. 2, lines 65-67. Cheng ‘362 fails to teach or suggest a base *formed of a single piece element extending substantially around the second end of the body*. Rather, Chang ‘362

describes a multi-part base having a pivot section (40 in Figures 1-7) that is formed of a flexible material to facilitate bending of the base. Col. 3, lines 17-20. The pivot section is *connected between* the front and rear sections. Further, Cheng describes the front and rear sections as “halves of the base seat and the pivot section is positioned at the center of the base seat.” See Cheng ‘362 col. 4, lines 21-23. Cheng also describes the front and rear sections as able to be “*connected* by an alternative measure” rather than by the aforesaid pivot section. *Id* at col. 4, lines 8-11. (Emphasis added) Therefore, Cheng ‘362 clearly fails to teach or suggest a base formed of a single piece element, as recited in independent claims 1 and 20. Accordingly, Applicants respectfully assert that claims 1 and 20 are patentably distinct from Cheng ‘362.

Dependent claims 6, 8-11, 15, 16 and 18 that depend from claim 1, as well as claims 21-25, 33, and 34 that depend from claim 20, are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein. Applicants respectfully request withdrawal of these rejections.

C. Claims 1, 4-11, 15, 16, 18, 20-28, 33, 34 and 36 Patentably Distinguish from Te-Pin

Claims 1, 4-11, 15, 16, 18, 20-28, 33, 34 and 36 stand rejected under 35 U.S.C. § 102(c) as being anticipated by U.S. Patent No. 6,568,527 to Te-Pin (hereinafter “Te-Pin”). Applicants respectfully traverse this rejection and request reconsideration.

As discussed above, independent claims 1 and 20 recite, among other features, a golf bag including a base, the base *formed of a single piece element that extends substantially around the second end of the body*. Applicants respectfully assert that Te-Pin fails to teach or suggest these features.

Te-Pin describes a golf bag that includes a base bracket. Col. 2, lines 48-49. The base bracket includes a front section, a rear section, a first flexible section disposed on the front section, a second flexible section disposed on the rear section and a connecting member connected between the first and second flexible sections. See Col. 2, lines 57-61 and FIGS. 1, 2, 4 and 5. The connecting member is disposed between the first and second flexible sections and is connected with outer edges of corresponding portions thereof. Col. 3, lines 33-35. A part of the connecting member is connected with the first and second flexible sections on the bottom of the base bracket, while another part is connected with the first and second flexible sections on

the lateral side of the base seat. Col. 3, lines 35-40. The first and second sections are “connected together to form a larger receiving space.” Col. 3, lines 40-41.

Clearly, Te-Pin fails to teach or suggest a base formed of a single piece element that extends substantially around the second end of the body. In fact, Te-Pin describes a base including multiple parts connected together. For instance, the connecting member of Te-Pin is “bridged and connected between the first and second flexible sections by way of stitching.” Col. 4, lines 15-17. Note also Figs. 2, 4 and 5 of Te-Pin. As such, Te-Pin specifically teaches away from a base formed of a single piece element that extends substantially around the second end of the body, as recited in claims 1 and 20. Applicants respectfully assert that independent claims 1 and 20 patentably distinguish from Te-Pin and request withdrawal of this rejection.

Claims 4-11, 15, 16 and 18 that depend from claim 1, as well as claims 21-28, 33, 34 and 36 that depend from claim 20, are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein. Applicants respectfully request withdrawal of these rejections.

D. Claims 1, 4, 7-11, 15, 16, 18, 20-27, 33, 34 and 36 Patentably Distinguish from Cheng ‘937

Claims 1, 4, 7-11, 15, 16, 18, 20-27, 33, 34 and 36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,564,937 to Cheng (hereinafter “Cheng ‘937”). Applicants respectfully traverse this rejection and request reconsideration.

As discussed above, independent claims 1 and 20 recite, among other features, a golf bag including a base, *the base formed of a single piece element that extends substantially around the second end of the body*. Applicants respectfully assert that Cheng ‘937 fails to teach or suggest such features.

Cheng ‘937 describes a golf bag including a base having a front section and a rear section. Col. 3, lines 3-4. The bottom of the front section is open and a driving board is connected to the front section via a connecting structure. Col. 3, lines 12-31. The golf bag base of Cheng ‘937 includes multiple parts. *See* FIGS. 2 and 3. Clearly, Cheng ‘937 fails to teach or suggest a base formed of a single piece element that extends substantially around the second end of the body. Accordingly, Applicants assert that independent claims 1 and 20 are patentably distinct from Cheng ‘937.

Claims 4, 7-11, 15, 16 and 18 that depend from claim 1, as well as claims 21-27, 33, 34 and 36 that depend from claim 20, are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein.

E. Claims 2, 29, 30, 38, 40-43, 46 and 47 Patentably Distinguish from the Combination of Cheng '762, Cheng '362, Cheng '937, or Te-Pin with Kang or Nelson

Claims 2, 29, 30, 38, 40-43, 46 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng '762, Cheng '362, Cheng '937 or Te-Pin in view of U.S. Patent Publication No. 2004/0200746 to Kang (hereinafter "Kang") or U.S. Patent No. 3,941,398 to Nelson (hereinafter "Nelson"). Applicants respectfully traverse these rejections and request reconsideration.

Claims 2 and 29-30 depend from claims 1 and 20, respectively. As discussed above, none of the Cheng references or Te-Pin teaches or suggests all the features of claims 1 and 20. The addition of Kang or Nelson fails to cure the deficiencies of the Cheng references or the Te-Pin reference with respect to claims 1 and 20. Accordingly, Applicants respectfully assert that claims 2, 29 and 30 are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein.

Independent claim 38 recites features similar to those recited in claims 1 and 20. For example, claim 38 recites, among other features, "[a] golf bag comprising: ...a base secured to the second end of the body, the base *formed of a single piece* element that extends substantially around the second end of the body" (Emphasis added). None of Cheng '762, Cheng '362, Cheng '937 or Te-Pin teaches or suggests the features of claim 38. The addition of Kang or Nelson fails to cure the deficiencies of these references with respect to claim 38 because neither Kang nor Nelson, alone or in combination, teaches or suggests this base formed of a single piece element. Accordingly, Applicants respectfully assert that claim 38 is allowable over the cited references.

Claims 40-43, 46 and 47 that depend from claim 38 are allowable for at least the same reasons as discussed above and further in view of the novel features recited therein. Applicants respectfully request withdrawal of this rejection.

F. Claims 12-14, 31, 32, 35-37, 44, and 45 Patentably Distinguish from the Combination of Cheng '762, Cheng '362, Cheng '937, or Te-Pin with Hamamori or Wen Chien

Claims 12-14, 31, 32, 35-37, 44, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng '762, Cheng '362, Cheng '937 or Te-Pin in view of U.S. Patent No. 6,648,137 to Hamamori (hereinafter "Hamamori") or U.S. Patent No. 6,298,988 to Wen-Chien (hereinafter "Wen-Chien"). Applicants respectfully traverse these rejections and request reconsideration.

Claims 12-14 that depend from claim 1, as well as claims 31, 32 and 35-37 that depend from claim 20, and claims 44 and 45 that depend from claim 38, are allowable for at least the same reasons described above with respect to their respective base claims. The addition of Hamamori or Wen-Chien fails to cure the deficiencies of the Cheng references and Te-Pin with respect to independent claims 1, 20 and 38. Accordingly, Applicants respectfully assert that dependent claims 12-14, 31, 32, 35-37, 44 and 45 are allowable over the cited combination of references.

G. Claims 48-55 Patentably Distinguish from the Combination of Cheng '762, Cheng '362, Cheng '937 or Te-Pin with Chang '497 or Cheng '383

Independent claim 48 recites, among other features, a golf bag comprising:

a base secured to an end of the body, the base having a foam element formed of a polymer foam material, and the base having at least a first wear element and a second wear element secured to an exterior surface of the foam element, wherein *the first wear element has a first configuration and the second wear element has a second configuration, the second configuration being different from the first configuration* and wherein at least one of the first and second wear elements is configured to contact a ground.

None of the Cheng references or Te-Pin teaches or suggests the features of claim 48. For example, none of the Cheng references or Te-Pin teaches or suggests at least a first and second wear element. The addition of Chang '497 or Cheng '383 fails to cure the deficiencies of the Cheng references or Te-Pin with respect to claim 48. None of the cited references, alone or in combination, teaches or suggests a first wear element and a second wear element having different configurations. Rather, the Chang '497 and Cheng '383 each recite a wear element. The wear elements have a configuration. However, neither Chang '497 nor Cheng '383, nor any of the cited references, teaches or suggests *two wear elements having two different*

configurations. Accordingly, Applicants respectfully assert that claim 48, as well as claims 49-55 that depend therefrom, are allowable over the cited references

H. Claims 17-19 Patentably Distinguish from the Combination of Cheng '762, Cheng '362, Cheng '937, or Cheng '383 with Any One of JP '250, Nevard and Yoshida

Claims 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng '762, Cheng '362, Cheng '937, or Cheng '383 in view of Japanese Patent No. 198250 (hereinafter "JP '250"), U.S. Patent No. 3,866,646 to Nevard (hereinafter "Nevard") or U.S. Patent No. 6,736,264 to Yoshida (hereinafter "Yoshida"). Applicants respectfully traverse these rejections and request reconsideration.

Claims 17-19 depend from claim 1. The addition of JP '250, Nevard and/or Yoshida fails to cure the deficiencies of the Cheng references with respect to claim 1. For instance, none of JP '250, Nevard or Yoshida teaches or suggests a base formed of a single piece element that extends substantially around the second end of the body. Accordingly, Applicants assert that claims 17-19 are allowable for at least the same reasons as their base claim and further in view of the novel features recited therein.

I. Claims 48-55 Patentably Distinguish from the Combination of Chang '497, Chang '383 with Hamamori or Wen-Chien and Kang or Nelson

Claims 48-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chang '497 or Cheng '383 in view of Hamamori or Wen-Chien and further in view of Kang or Nelson. Applicants respectfully traverse these rejection and request reconsideration.

None of the cited references, alone or in combination, teaches or suggests the features of claim 48. For instance, none of the cited references teaches or suggests a base having a first wear element and a second wear element secured to an exterior surface of the foam element, wherein *the first wear element has a first configuration and the second wear element has a second configuration, the second configuration being different from the first configuration*, as recited in claim 48. Accordingly, Applicants respectfully assert that claim 48, as well as claims 49-55 that depend therefrom, are patentably distinct from the cited combination of references.

CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner believe that a telephonic or in-person interview would aid in prosecution of this matter, Applicants urge Examiner to contact the undersigned attorney.

Please charge all fees in connection with this communication to Deposit Account No. 19-0733.

Respectfully submitted,

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